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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/759,931

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Karen A. Anders

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09/06/2006

Barry S. Newberger
1201 Main Street
P.O. Box 50784
Dallas, TX 75250-0784

EXAMINER

SHAH, AMEE A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,931

Applicant(s)

ANDERS ET AL.

Examiner

Amea A. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 26-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/28/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-49 are pending in this action.

Response to Amendment

Applicant's amendment, filed June 28, 2006, has been entered. Claims 1 and 5 have been amended. Claims 26-49 have been added. In light of the amended claims, the 35 U.S.C. §112 rejections are withdrawn. New drawings have been submitted. In light of the new drawings, particularly new Fig. 2A which now shows reference number 214 and only one 212, and the amended specification, the objections to the drawings are withdrawn.

Election/Restrictions

Newly submitted claims 26-45 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons. Independent claims 26, 34 and 44 and their dependencies are directed to a method and apparatuses for delivering Web content. These claims are limited to a network/Web environment and include additional steps and functions not required by claims 1, 14 and 19, such as validating the user identification, determining eligibility by authenticating the user, determining if a service quantity is available and displaying the requested Web content. Claims 1, 14, 19 and their dependencies are directed to a method and apparatuses for entitlement management which do not necessitate a network or Internet, i.e. the steps of the method and functions of the apparatuses do not require that the request, determination of eligibility or delivery of service be conducted through a network such as the Internet.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-45 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

Applicant's arguments filed June 28, 2006, have been fully considered but they are not persuasive.

In response to applicant's argument regarding claims 1, 10 and 19 that Svancarek et al., US 2004/0039705 (hereafter referred to as "Svancarek") does not disclose comparing a set of administrator-configurable package profile attributes values with corresponding values for the recipient (Remarks, page 16), the Examiner disagrees. Svancarek discloses determining eligibility by determining, for example, whether the customer is in a participating region and/or has a participating software product (page 4, ¶0034). The package profile attributes, as noted in the prior Office Action, are the geographic region and software product, which correspond to the examples of attributes cited by applicant in the Specification (page 7). In order to determine whether the geographic region is participating, a comparison must be made between the recipient value for region and the package profile value for participating region. The participating region is inherently administrator-configured. Therefore, Svancarek discloses comparing a set of administrator-configured attributes (i.e. the participating geographic region and/or software product) with corresponding values for the recipient in order to determine eligibility.

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In response to applicant's argument regarding claims 3, 12 and 21 that Svancarek does not disclose configuring a set of package attributes (Remarks, page 17), the Examiner disagrees. As discussed above, the attributes as to which geographic locations and/or software programs are participating must be configured.

In response to applicant's argument regarding claims 4, 13 and 22 that Svancarek does not disclose determining if the service includes a limited number of accesses (Remarks, pages 17-18), and if it does, decrementing a tracking count (Remark, page 18), the Examiner disagrees. Svancarek discloses determining "whether the already-used product has previously resulted in the distribution of a set number of additionally product keys, such as for example 3-5. In such case, it may be that the customer should be directed elsewhere to obtain a volume license or a multi-machine license." (Page 4, ¶0035) As noted in the previous office action, limited number of accesses is the set number of product keys. The service is the product, which corresponds to applicant's definition of service in the Specification (page 2). The determination if the service includes a limited number of accesses is the determining of whether the product has previously resulted in a set number of keys or whether there is a volume license. Furthermore, the activation database tracks each delivered product key and determining whether each has been employed by updating the database as each key is used, i.e. decrementing the number of accesses by one (Svancarek, page 5, ¶¶0042-0043).

In response to applicant's argument regarding claims 9, 18 and 25 that Svancarek does not disclose logging a delivery of a service (Remarks, pages 18-19), decrementing a number of available instances if there is a limited usage amount (Remarks, pages 19-20) or sending a message to the recipient indicating the recipient is not entitled to the service is the usage count

has been consumed (Remarks, page 20), the Examiner disagrees. As stated in the previous Office Action, Svancarek discloses the reporting service storing in a database information logged at the portal (page 5, ¶0041), the information allowing the provider to track the history of the copy of the software product and distributed product keys, i.e. delivery of service. Therefore, Svancarek discloses the history of the delivery of service being stored, i.e. logged. Furthermore, as discussed in the prior Office Action, the limited usage amount is one or a set number (page 4, ¶0035) and if the recipient has exceeded his usage amount, a message is sent by directing the customer elsewhere (page 4, ¶0035).

In response to applicant's argument regarding claims 5, 8, 14, 17, 23 and 24 that the Office Action has not presented a prima facie case of obviousness (Remarks, pages 21-23), the Examiner disagrees, because all three conditions to establish a prima facie case of obviousness are met in the previous office action and below. Combined teachings of Svancarek and Talbot et al., US 2002/0116312 A1 (hereinafter referred to as "Talbot") teach all the limitations of claims 5, 8, 14, 17, 23 and 24, as analyzed in the previous office action and below. Secondly, Svancarek teaches, as discussed with reference to claim 1 above, comparing attributes. Thirdly, Talbot teaches the limitation of determining whether the attribute is single-valued or not, which is recited in claims 8, 17 and 24 as those claims are dependencies of claims 5, 14 and 23 and therefore the limitations of claims 5, 14 and 23 are read into 8, 17 and 24. Therefore, in view of Talbot, it would be obvious to a person of ordinary skill in the art at the time of the invention to modify Svancarek to incorporate Talbot's feature of determining whether the attributes are single-valued or not to better filter criteria, as suggested by Talbot (page 2, ¶0012).

In response to applicant's argument regarding claims 5, 8, 14, 17, 23 and 24 that the motivation to combine is insufficient (Remarks, pages 23-24), the Examiner disagrees. The motivation to modify Svancarek to incorporate Talbot's feature may be another advantage than that which applicant intends. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, the motivation to combine of filtering criteria better to allow for a service provider to offer their services to those more likely to desire them or to those providers desire more by using provider-driven filtering criteria, is sufficient.

In response to applicant's argument regarding claims 7 and 16 that the non-functional descriptive language must be given patentable weight (Remarks, page 25), and that the motivation to combine is inadequate (Remarks, page 26), the Examiner disagrees and states that *In re Gulack* and *In re Lowrey* were properly applied. As discussed in the previous office action and below, the data to be displayed when the recipient is found ineligible does not change the function being performed of displaying data. The presenting of alternate content would be performed in the same manner regardless of the exact composition of the content, whether a message, an alternate website or a description of criteria. Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art Svancarek in terms of patentability.

Examiner Notes

(1) Examiner interprets claims 10-18 to be directed to a computer program product embodied in a tangible storage medium that is executable by a computer or processor, per the Specification (page 13, lines 1-20), and therefore is statutory under 35 U.S.C. §101.

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(2) Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 9-13, 15, 18-22 and 25 are rejected under 35 U.S.C. 102(e)(1) as being anticipated by Svancarek et al., US 2004/0039705 A1 (hereinafter referred to as “Svancarek”).

Referring to claim 1. Svancarek discloses a method for entitlement management comprising:

- responsive to a request for a service (page 3, ¶0031), determining if a recipient identified in said request is entitled to said service (page 4, ¶0034);

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- if said recipient is entitled to said service, delivering said service (page 4, ¶0036),
- wherein said step of determining if said recipient is entitled to said service comprises comparing a set of administrator-configurable package profile attributes values associated with a package of services containing said service with corresponding values for said recipient (page 4, ¶0034 – note the attributes are contained in the eligibility service and can be a participating region or participating software product).

Referring to claim 2. Svancarek also discloses the method of claim 1 further comprising if, responsive to said determining step, if said recipient is not entitled, sending a message to said recipient indicating said recipient is not entitled to said service (pages 3-4, ¶¶0031, 0032 and 0035).

Referring to claim 3. Svancarek also discloses the method of claim 1 further comprising configuring said set of package attributes wherein said set of package attributes includes selected attributes having one or more attribute values (page 4, ¶¶0034, 0036 and 0037).

Referring to claim 4. Svancarek also discloses the method of claim 1 further comprising:

- determining if said service includes a limited number of accesses (pages 4 and 5, ¶¶0035 and 0042 – note the limited number of accesses is if the key was already used); and
- if said service includes a limited number of accesses, decrementing a tracking count associated with the service (page 5, ¶¶0042-0043).

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Referring to claim 6. Svancarek further discloses the method of claim 2 wherein the step of sending said message comprises presenting said recipient with alternate content (page 4, ¶¶0032-0033 – note the alternate content is the website to which the user is redirected).

Referring to claim 9. Svancarek also discloses the method of claim 4 further comprising:

- logging a delivery of said service (Fig. 3 and pages 4-5, ¶¶0040-0042);
- decrementing a number of available instances of said service if said service has a limited usage count (Fig. 3 and page 5, ¶0042); and
- sending a message to said recipient indicating said recipient is not entitled to said service if the limited usage count has been consumed (page 4, ¶0035).

Referring to claims 10-13, 15, 18-22 and 25. All of the limitations in apparatus claims 10-13, 15, 18-22 and 25 are closely parallel to the limitations of method claims 1-4, 6 and 9, analyzed above and are rejected on the same bases.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 8, 14, 17, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svancarek over Talbot et al., U.S. Pat. App. Pub. No. 2002/0116312 A1 (hereinafter referred to as “Talbot”)

Referring to claims 5 and 8. Svancarek discloses the method of claim 1, as discussed above, wherein said substep of comparing a set of package profile attributes values associated with a package of services containing said service with corresponding values for said recipient comprises determining if said recipient is not entitled if a or each value of said current attribute and a corresponding value for said recipient miscompare (page 4, ¶0034). Svancarek does not expressly show determining if the current attribute is single-valued or not. Talbot, in the same field of endeavor of e-shopping, discloses a reverse blind credit auction between a borrower and at least one lender to which the borrower is matched using various criteria, including determining if the attribute value is single-valued or not (Talbot, page 4, ¶¶0043-0044 – note the attribute is the exclusion).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Svancarek to include the teachings of Talbot to allow for determining whether the current attribute is single-valued or not. Doing so would allow for a service provider to offer their services to those more likely to desire them or to those providers desire more by using provider-driven filtering criteria, as suggested by Talbot (page 2, ¶0012).

Referring to claims 14, 17, 23 and 24. All of the limitations in apparatus claims 14, 17, 23 and 24 are closely parallel to the limitations of method claims 5 and 8, analyzed above and are rejected on the same bases.

Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svancarek

Referring to claim 7. Svancarek discloses the method of claim 6, as discussed above, but does not explicitly disclose wherein said alternate content includes a description of criteria for said requested service. As analyzed above, Svancarek shows presenting the recipient with alternate content when the recipient is not entitled to the requested service. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the presenting step recited. The data to be displayed when the recipient is found ineligible does not change the function being performed. The presenting of alternate content would be performed in the same manner regardless of the exact composition of the content, whether a message, an alternate website or a description of criteria. Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art Svancarek in terms of patentability. *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to present alternate content obtain when the recipient is ineligible for the service regardless of the specific composition of the content, whether a message, an alternate website or a description of criteria, because such content does not functionally relate to presenting step and also because the content to be displayed does not patentably distinguish the claimed invention.

Referring to claim 16. All of the limitations in apparatus claim 16 are closely parallel to the limitations of method claim 7, analyzed above and are rejected on the same bases.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

August 31, 2006



Kristy A. Smith
Primary Examiner